

Appl. No. 09/746,611
Response to Office Action mailed April 20, 2004
Response transmitted July 19, 2004

Attorney Docket No. 10022/24

REMARKS

1. The Application has Claims 1-38 pending. The Examiner is thanked for withdrawing previous rejections under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 6,219,654 to Michael Ruffin ("Ruffin"). In the present Office Action, Claims 1-17, 22, and 32-38 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claim 2 is objected to under 37 C.F.R. § 1.75(c) as being of improper decedent form for failing to further limit the subject matter of a previous claim. Claims 1-7, 10-14, 16-21, 25-33, 35-36, and 38 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 6,581,040 to Daniel Wright et al. ("Wright"). Finally, Claims 8, 9, 15, 22-24, 34, and 37 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,581,040 to Daniel Wright et al. ("Wright"), as applied above.

2. Examiner Colon and Primary Examiner Romain Jeanty granted the undersigned an interview on June 3, 2004, to discuss the case. Claims 1 and 32 were discussed. The Examiners asked the undersigned to show the novelty of the claims and to explain the "structures" of the proposals. The undersigned explained the meaning of the claim term "structure" and its relation to the claim term "proposal." Agreement was not reached as to allowability of the claims.

3. Claims 1-17, 22, and 32-38 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The rejection states that the use of the term "structures" is indefinite because one is unsure as to whether Applicants are referring to the proposals or to the "components that the proposal comprises such as an alliance, acquisition, equity venture, partnership or venture." Office Action, p. 2, lines 18-21. Claim 1 has been amended in a non-narrowing manner to recite the claim term "structures" to overcome the rejection. Amended Claim 1 recites "the proposal includes at least two structures selected from the group consisting of an alliance, an acquisition, an equity venture, a partnership, and a venture."

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Claim 1 has also been rejected for indefiniteness under 35 U.S.C. § 112, second paragraph, because of the multiple use of the claim term "information" in amended Claim 1. The rejection states that the use of the term "information" is vague and indefinite because it is unclear if the "information gathered on other proposals comprises the same information as defined in the first limitation. It is also unclear whether the evaluation is occurring on the information gathered from both the first *and* second limitations." Office Action, p. 3, lines 4-7 (emphasis in the original). Claim 1 has been amended to overcome this rejection by removing the second reference to the limitation of accessing information.

Claim 22 is also rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, because it "does not set forth any steps positively reciting the method/process." Office Action, p. 4, lines 10-12. Claim 22 has been amended to overcome this rejection as suggested by the Examiner. Claim 32, also rejected under 35 U.S.C. § 112, second paragraph, has been amended to recite the use of the gathered data in calculating and in generating an output, as suggested by the Examiner.

Accordingly, the claim terms "structures" and "information" are not indefinite, and the Examiner is respectfully requested to withdraw rejections for indefiniteness of Claims 1, 22 and 32, and claims depending from them, Claims 2-17 and 33-38.

4. Claim 2 is objected to as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 2 has been amended to further limit the subject matter of a previous claim and to correct the improper dependent form objected to in the Office Action. Support for the amendment is found at least in the specification at p. 6, line 18, to p. 7, line 3. The Examiner is request to withdraw the objection to Claim 2.

5. Claims 1-7, 10-14, 16-21, 25-33, 35-36, and 38 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Pat. No. 6,581,040 to Daniel Wright et al. ("Wright"). The Office Action states that Wright discloses a method of evaluating a

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business proposal and that Wright discloses all the steps of the above-mentioned claims. Applicants traverse the rejection. Wright is directed to a "project specific communications systems and method" and does not describe or suggest evaluating business proposals as claimed.

As to the first step of amended Claim 1, gathering information on the proposal, the Office Action cites several passages from Wright and concludes that Wright discloses that "the system gathers information on proposals submitted by resource providers for projects." Office Action, p. 6, lines 1-2. Each passage cited in the Office Action refers to some aspect of bids on a construction project.

It is clear from the passages that something will be built, that bids will be made, and that the owner will take a number of steps during the project, such as selecting a general contractor (col. 2, lines 39-58); helping resource providers (col. 3, lines 51-55); preparing project details for resource providers to bid on (col. 4, lines 39-59); allowing participants to cooperate (col. 5, line 45 to col. 6, line 37, and esp. col. 6, lines 5-6); providing a database with different levels of access (col. 7, lines 29-60); entering specifications (col. 8, lines 7-30); and allowing vendors to input information and to access information about suitable projects (col. 8, line 62, to col. 9, line 18).

These passages detail steps in a construction project, which could conceivably relate to the "proposal" of amended Claim 1. However, the first step of amended Claim 1 requires not merely gathering information, but that the information be relevant to a business proposal. Further, the proposal must include at least two structures selected from the group consisting of "an alliance, an acquisition, an equity venture, a partnership, or a venture." Even if Wright disclosed a single method of evaluating a business proposal (which he fails to do), Wright does not disclose or suggest submission of two structures for the same proposal and then evaluating and ranking the at least two structures.

These structures are discussed in the specification, and in particular in the first two paragraphs of p. 6, lines 1-17. These paragraphs discuss proposals, and note that the proposal may take on one of many forms, such as a venture, a separately-owned

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venture, a jointly-owned venture, an alliance, an acquisition, and so on. Those skilled in the art will recognize that ownership may take on many forms, such as equity or debt, or that a joint venture may be owned 50/50 or in some other combination, such as 75/25. These possibilities, and many others, are inherently part of the claim terms "an alliance, an acquisition, an equity venture, a partnership, or a venture."

The criteria for evaluating the structures are also discussed in the specification, at page 18, lines 1-23. Many of these criteria are captured in dependent Claims 4 and 25. However, other criteria may be used, such as those described on p. 15, lines 20, to p. 16, line 9. Claim 1 is not limited merely to the criteria recited in Claim 4; evaluations may be made by using any reasonable factors contained in the information gathered.

Independent Claim 18 also contains the "two structures" limitation, while independent Claim 32 recites that "the proposal includes a plurality of structures." The Office Action cites no passage of Wright for the "two structures" limitation or "a plurality of structures" limitation. Thus, the rejection fails to demonstrate that Wright discloses all the limitations of Claim 1. Therefore, Wright does not anticipate independent Claims 1, 18 and 32.

Wright also does not anticipate the dependent claims of the application because Wright does not recite many of the limitations of the dependent claims. Wright does not anticipate amended Claims 4 and 25, because Wright does not describe or teach a method of evaluating a proposal or calculating an advantage of a proposal by calculating at least one of a revenue stream, a return on average assets, a return on investment, a return on equity, an internal rate of return, and a net present value. Wright also does not describe or teach the techniques claimed in the present invention for making the method easy for users. These techniques include the radio-button technique of Claim 6, the graphical user interface of Claims 7, 16, 17, 30, 31 and 33, the drop-down screen, scroll screen, check box and list box of Claims 12 and 13, the numerical or pseudo-numerical inputs and outputs of Claims 16 and 17, and the control-action-response technique of Claim 38. The Examiner is respectfully requested to withdraw the rejections of Claims 1-7, 10-14, 16-21, 25-33, 35-36, and 38.

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6. Claims 8, 9, 15, 22-24, 34 and 37 are also rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,581,040 to Daniel Wright et al. ("Wright").

Claims 8, 9, 15, and 37

Per the discussions above for Claims 1 and 32, Claims 8, 9, 15, and 37 are allowable because Wright does not disclose all the limitations of Claims 1 and 32, which are therefore allowable. Accordingly, the Examiner is requested to withdraw rejections of Claims 8, 9, 15, and 37 under 35 U.S.C. § 103(a).

Claims 22-24 and 34

The rejection admits that Wright does not expressly disclose the method and computer system of Claims 18 and 32, nor, as per Claims 22 and 34, does Wright expressly disclose the step of entering information concerning the strength of a business relationship by entering a number from 1 to 5 (Claim 22) or receiving an output rating of 1 to 5 (Claim 34). Office Action, p. 14, lines 6-9. However, states the rejection, Wright does disclose that information such as capabilities, ratings, and preferences are used to evaluate resource providers and to assess which providers would complement each other on a project, which is a form of measuring the strength of a business relationship. Office Action, p. 14, lines 10-14. Therefore, states the rejection, it would have been obvious to one having skill in the art to use a number from 1 to 5 to indicate the strength of a business relationship because this provides a quantitative assessment which is easy for users to comprehend.

Applicants traverse the rejections. As stated in the rejection, Wright does NOT expressly disclose the use of numbers to evaluate the strength of a business relationship. Wright further does not disclose the use of numbers to evaluate capabilities, ratings, and preferences for resource providers for a project. See Wright, col. 9, lines 19-45, which merely provides that "qualified resource providers post to the system database at Block 30 their intent to bid." Col. 9, lines 27-28. This passage also

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states that the providers may ask questions or post comments. This does not describe or suggest rating the suppliers, and does not describe or suggest any way of measuring a strength of a business relationship.

Furthermore, the passages cited do not describe or suggest a computer system in which there resides a computer program to gather inputs and to output an evaluation or ranking of suppliers or venders. The only mention of "rating" states that once project details are available,

these project details are available for matching with other resource provider templates resulting in screening and selection according to resource providers capabilities, ratings, and preferences. As the system screening is performed, information [is] sent out to the qualified resource providers at Block 28.

Wright, col. 9, lines 19-25. This passage does not describe or suggest alternate structures of a proposal with numerical inputs and outputs. It is a straightforward listing of details for subcontractors for a project whose phases and structure are sufficiently well known to gather bids. It has no connection whatever to the present invention, in which two or more structures for a proposal, or a plurality of structures for a proposal, are evaluated. Amended Claim 22 and Claim 34 are not described or suggested, nor are the claims depending from them, Claims 23-24.

Accordingly, Claims 8, 9, 15, 22-24, 34 and 37 are allowable. The Examiner is respectfully requested to withdraw rejections of these claims under 35 U.S.C. § 103(a) as unpatentable over U.S. Pat. No. 6,581,040.

7. The Examiner is thanked for the courtesy of the interview on June 3, 2004. Claims 1, 2, 4, 18, 22, 25, 32, 33 and 36 have been amended. No new matter was added in amending the claims. The Examiner is requested to reconsider the application and to withdraw the rejections under 35 U.S.C. §§ 102(e), 103(a), and 112, second paragraph. Applicants have amended the claims following the Examiner's suggestion so that are not indefinite. Applicants have explained how the cited reference does not anticipate or make obvious the claims of the application. The Examiner is respectfully

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requested to call the undersigned if this will be of assistance to the Examiner or will expedite the allowance of the claims in this case.

Respectfully submitted,



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